

**REMARKS**

Claims 1, 4-9, 11, 28-33 are pending in this Application. Claims 2, 3, 10 and 12-24 were previously canceled. Claims 25-27 were previously withdrawn without prejudice and are canceled with this amendment. No claim has been added or amended.

**Notice of Improper Request for Continued Examination (RCE)**

Please note that an IDS was filed on May 18, 2009, with an RCE, and a Notice of Improper Request for Continued Examination ("Notice") was received. A copy of the Notice is attached, as required by the Notice, and this response is provided as a proper submission under 37 CFR 1.114. The RCE fee under 37 CFR 1.17(e) has been paid previously. Grant of the RCE and consideration of this paper is respectfully requested.

**Supplemental IDS Statements dated 2/2/09 and 10/21/08**

Several references listed on the IDS statements did not properly identify their dates and were not considered. A supplemental IDS is provided herewith that provides their respective dates and is respectfully submitted for the Examiner's consideration.

**Terminal Disclaimers / Rejection for Obviousness-Type Double Patenting (ODP)**

Claims 1 and 4-11 were previously rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. 6,506,248 B1 and 6,346,146 B1. Terminal Disclaimers drawn to U.S. Patent No. 6,506,248 B1 and 6,346,146 B1, respectively, were previously provided but were deemed improper, and not approved.

The terminal disclaimers submitted on February 6, 2009, were deemed improper on the basis that the "attorney listed in each terminal disclaimer is not an attorney of record." However, under 37 C.F.R. 1.321(b)(1)(iii) and (c)(2), a terminal disclaimer may

be signed by the *assignee* of record of the entire interest. To that end, each terminal disclaimer was executed by officers (Russell Chenu, the Chief Financial Officer, and Robert Cox, the General Counsel) of James Hardie International Finance, B.V., the assignee of the pending application by virtue of the assignment recorded with the United States Patent and Trademark Office (on May 17, 2004 at Reel 014636, Frame 0257) and having rights in the application through the Statement Under 37 C.F.R. 3.73(b) filed April 12, 2006. Thus, in compliance with the rules, the terminal disclaimers were signed by the assignee of record. Reconsideration for approval of the terminal disclaimers is respectfully requested.

**New Matter**

Applicant acknowledges with appreciation the Examiner's withdrawal of the rejection under 35 U.S.C. 112, first paragraph.

**Rejection under 35 U.S.C. § 102 (a) and (e)**

In consideration of the Examiner's position that the prior art rejections would likely be withdrawn and allowance of the claims resulting with the acceptance of the terminal disclaimers, Applicants respectfully submit that Claims 1, 4-9, 11, and 28-33 are in condition for allowance.

However, for the sake of providing a complete response to the pending Office Action, the remarks provided previously are reiterated as follows. The claims are rejected under § 102(a) and (e) as being anticipated by each of two patents filed by Duselis *et al.*, U.S. Patent Nos. 6,506,248 ("Duselis '248") and 6,346,146 ("Duselis '146"). The basis is that "Duselis *et al.* teach a composition comprising a combination or blend of bleached and unbleached cellulose fibers in amounts overlapping

applicant's claims...and thus anticipate applicant's claims." Duselis *et al.* teaches a broad range or genus. But a broad range or genus does not anticipate a specific range like that recited in Claims 1 and 29 that recite a range of 12 to 17 weight percent of bleached fibers relative to the total cellulose fiber content. This range is not anticipated by Duselis *et al.* Overlapping ranges fails to anticipate a recited species range if a specific embodiment is not disclosed. As explained in MPEP § 2131.03, a prior art genus cannot anticipate a claimed species, where the prior art range is not supported by a specific embodiment. The Duselis references do not suggest the unexpected improvements in strength that 12 to 17 weight percent bleached fibers conveys to a fiber cement composition that are clearly reflected by Figures 2 through 4 concerning enhanced modulus of rupture (Fig. 2), strain (Fig. 3), and toughness (Fig. 4).

#### **Rejections under 35 U.S.C. § 103**

The rejection under § 103(a) is in view of each Duselis reference, or alternatively, in view of Cook *et al.* (U.S. Patent No. 6,942,726) and Gregerson *et al.* (EP 263723).

The Examiner states that the Duselis references do not teach specific fiber types (Office Action, p. 4) or lengths (Office Action, p. 5). As discussed above, neither Duselis reference suggests the unexpected results in improved modulus of rupture, strain and toughness that fiber cement composites exhibit having 12 to 17 weight percent bleached fibers per total fibers demonstrated by Figures 2, 3, and 4 (modulus of rupture, strain, and toughness, respectively). The Duselis references do not suggest the unexpected results achieved by a composite material having bleached cellulose fibers comprising between 12 and 17 weight percent of the total cellulose fiber content

recited in independent Claims 1, 28 and 30, which Applicant respectfully and verily submits are patentably distinguishable over the Duselis references. Cook *et al.* is relied on for the teaching of specific examples of cellulose fibers and relies on Gregerson *et al.* for the teaching of specific fiber lengths. Gregerson fails to teach or suggest the recited proportion of bleached fibers of between about 12 to 17 weight percent, and in fact, Gregerson would find the result surprising considering that in most cases Gregerson teaches utilizing the bleached to unbleached fibers in a ratio of three to one and provides no teaching or suggestion of the unexpected results obtained with the recited concentration of bleached fibers. Gregerson in combination with Duselis and Cook also fails to teach or suggest the claimed invention of Claims 1, 28 and 30. For at least these reasons, dependent Claims 4-9, 11, 29, and 31-33 are also believed to be patentable and applicant respectfully requests their reconsideration for allowance.

Applicant hereby authorizes the Commissioner to charge any additional fees or refunds that may be required or owed to Gardere Wynne Sewell LLP Deposit Account No. 07-0153.

**Please direct all correspondence to the practitioner listed below at  
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Respectfully submitted,  
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